REMARKS

Claims 1-10, 16-17, and 20-49 are pending in the application. Reconsideration in light of the following arguments is respectfully requested and allowance is earnestly solicited.

Claim Rejection 35 U.S.C. § 103(a)

35 U.S.C. § 103(a)

Claims 1-10, 16, 17, and 20-49 stand rejected as obvious under 35 U.S.C. § 103(a) in view of Cheston et al., United States Patent Number 6,167,494 (hereinafter, Cheston) in view of Ohran, United States Patent Number 6,085,298 (hereinafter, Oran). Applicants respectfully disagree.

When applying 35 U.S.C. 103, the following tenets of patent law must be adhered to: (A) the claimed invention must be considered as a whole; (B) the references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination; (C) the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and (D) reasonable expectation of success is the standard with which obviousness is determined. *See MPEP § 2141 and Hodosh v. Block Drug Co., Inc.,* 786 F.2d 1136, 1143 n.5, 220 USPQ 182, 187 n.5 (Fed. Cir. 1986).

The Office is correct that the Cheston reference fails to teach the present invention which is directed, generally, to a method wherein configuration data (which may include hardware driver data and software configuration data) is backed-up and is subsequently accessible via a non-interactive user input. The Office is incorrect that Orhan corrects this deficiency.

First, there is no motivation to combine Cheston with Orhan as Orhan is directed to backing-up data, while Cheston is directed to backing up all data. *Cheston* repeatedly notes that "substantially all of the data" stored in the first segment must be copied to the second segment. *See Cheston* Col. 2, line 48; Col. 2, lines 51-52; Col. 3, lines 33-37; Col.

3 lines 48-49; Col. 3, lines 52-53; Col 5, lines 4-7 (referring to the sectors forming the data); Col. 6, lines 8-10 (referring to the physical size of the segments). In fact, *Cheston* teaches that "substantially" all the data must be copied to the second segment (thus the need for a second segment at least equal to the first). *Cheston*, Col. 6, lines 9-10. Further, Cheston indicates that changes to the operating system (OS) are a particularly difficult and unique problem because the computer may not function or a boot disk may be required. Cheston, Col. 1, lines 25-39. As the Office is aware, "[I]t is necessary to ascertain whether the prior art teachings would appear to be sufficient to one of ordinary skill in the art to suggest making the claimed substitution or other modification." *In re Lalu*, 747 F.2d 703, 223 USPQ 1257, 1258 (Fed. Cir. 1984). Neither the Cheston reference nor the Orhan reference suggest making the substitution, as the Orhan system simply backs-up data which has been changed while the Cheston reference copies all data. Thus, Orhan when taken as a whole simply suggests backing up data which has changed instead of the entire data (thus saving time, which is especially exacerbated in a massive storage system). Further, since Cheston on the whole teaches backing up all data, and Orhan on the whole teaches solely backing up data which has been changed, the two references are entirely conflicting.

As the Federal Circuit has noted, [t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. . . . It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *In re Oetiker*, 977 F.2d 1443, 24 USPQ 2d 1443 (Fed. Cir. 1992) *quoting In re Fine*, 837 F.2d 1071, 1075, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988). Thus, there is no motivation to combine as the references teach away from the asserted combination.

Even if one were to combine Cheston with Orhan, one would not arrive at the present invention because Cheston, as modified by Orhan, discloses a system and method for backing-up a mass storage device wherein only changed data is backed-up. Orhan fails to teach backing-up a known good configuration consisting essentially of at least one of hardware configuration parameter or software configuration parameter as recited in Claim 1 and 16 rather than the asserted combination. Thus, the combination of Cheston and Orhan may back-up data which is not necessarily a known good.

Further, the Office's assertion "Ohran's teaching of backup only data needed would reduce the cost for Cheston's system by reducing the memory storage capacity for storing the smaller size of the backed-up version" (Instant Action, Page 3) is incorrect. Cheston on the whole teaches, "[t]he capacity of disk drives used in such computers is now so high that it is unlikely that an average end user will ever require all the space available." Cheston, Col. 1, lines 24-26. "A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention." *M.P.E.P. 2141.02; citing W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). Emphasis added. Thus, the references themselves teach away from making the asserted combination. In light of the foregoing, removal of the pending rejection to Claims 1-10, 16, 17, and 20-49 is respectfully requested and allowance earnestly solicited.

As the pending rejection to Claims 2 and 17 (Numbered 6) is merely a reiteration of the immediately preceding Office Action, Applicants will not burden the record further and respectfully resubmit their arguments from the Response dated October 14, 2003.

Regarding Claims 3-6, Applicants respectfully note that Claim 3-6 depend from Claim 1 which was amended in the immediately preceding paper. Removal of the rejection is requested and allowance solicited.

Regarding Claim 7, Applicants note that Ohran teaches merely saving changed data. Ohran individually or in combination with Cheston fails to teach storing a known good configuration consisting essentially of at least one of hardware configuration parameters and software configuration parameters. In light of the forgoing, allowance of Claim 7 is respectfully requested.

As the pending rejection to Claims 8 and 9 (Numbered 9 and 10 respectively) is merely a reiteration of the immediately preceding Office Action, Applicants will not burden the record further and respectfully resubmit their arguments from the Response dated October 14, 2003.

Regarding the pending rejection under 35 U.S.C §103(a) to claim 9, Applicants respectfully request removal of the pending rejection and allowance of the claim in light of the foregoing arguments.

As the pending rejection Numbered 11 through 23 is merely a reiteration of the immediately preceding Office Action, Applicants will not burden the record further and respectfully resubmit their arguments from the Response dated October 14, 2003. Applicant notes Claim 36 has been amended to more particularly point out the present invention. As neither Cheston, nor Ohran, either individually, or in combination teach storing a known good configuration consisting essentially of at least one of hardware or software, Claim 36 is believed to be in a condition for allowance which is earnestly solicited.

With respect to the pending rejection to Claims 42-49, Claims 42-49 depend from Claim 36 which has been amended to more particularly point out and distinctly claim the present invention it is believed that Claims 42-49 are in a condition for allowance.

CONCLUSIONS

In light of the forgoing, reconsideration and allowance of the claims is earnestly solicited.

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Respectfully submitted,

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